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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/070,831	07/08/2002	Ulrich Carlin Nielsen	742113-10	2536

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EXAMINER

RODRIGUEZ, JOSEPH C

ART UNIT	PAPER NUMBER
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3653

DATE MAILED: 12/11/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/070,831	NIELSEN, ULRICH CARLIN	
	Examiner	Art Unit	
	Joseph C Rodriguez	3653	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 July 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>5</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Specification

The disclosure is objected to as lacking appropriate section headings as outlined in 37 CFR 1.77. See also 37 CFR 1.72-1.77; MPEP § 608.01(a). Correction is required.

This application does not contain an abstract of the disclosure as required by 37 CFR 1.72(b). An abstract on a separate sheet is required.

Claim Objections

The claims are also objected to because of the following informalities:

Claim 1 should read "A method" (ln. 1).

Claims 2-5 should read "The method according" (ln. 1).

Claim 6 should read "An apparatus" (ln. 1).

Claims 7-9 should read "The apparatus according" (ln. 1).

Applicant's claims are also replete with words improperly coupled together (e.g., "liftedfree" (claims 2, ln. 3); "weightdetermination" (claim 3, ln. 2 and claim 8, ln. 3); "positiondetermination" (claim 4, ln. 2);

Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 2 and 7 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Here, Applicant claims "a weighing arrangement which is integrated with the gripping element" (claim 2) and "in the robot's gripping system there is inserted a weighing device" (claim 7), however, Applicant does not teach these features in the specification. That is, the specification does not show a weighing device *integrated or in* the gripping system, but rather the weighing device is separate from the gripping system, such as a weighing platform. Consequently, Applicant's claims are not properly enabled.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding these claims, the language "i.e.," "possibly also", "alternatively as required" and "can be" that is found throughout the claims renders the claims indefinite as it is unclear whether the features subsequent to this type of language are a necessary part of the claimed invention. Applicant must *positively recite* the features of

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the claimed invention. Examiner thus recommends eliminating all instances of this type of language from the claim language.

Further, Examiner also recommends changing the European style claim language found in the method claims into standard U.S. PTO claim language by using transitional language such as "comprising" or "consisting of" to clearly indicate the features of the claimed invention. Without this transitional language, as in Applicant's current claims, it is unclear whether features are merely part of the preamble or are part of the claimed invention.

Further, Examiner also recommends using the gerund form of verbs to clearly establish the method steps (e.g., *weighing* said articles, and *transporting* said articles) as the actual method steps are unclear as currently presented.

Further, regarding claim 3, the language "negative weighing... in said supply position and that the item weight is registered as a weight reduction" is nonsensical. Here, it is unclear what specific step is being performed even in light of the specification. Examiner requests clarification.

Claim 1 recites the limitation "the robot type" (near ln. 15). There is insufficient antecedent basis for this limitation in the claim.

Claim 4 recites the limitation "the robot equipment" (ln. 1). There is insufficient antecedent basis for this limitation in the claim.

Claim 6 recites the limitation "the related selective control" (near ln. 20). There is insufficient antecedent basis for this limitation in the claim.

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Claim 6 recites the limitation "its" (near ln. 22). There is improper antecedent basis for this limitation in the claim as it is unclear what "its" is referring to.

Claim 6 recites the limitation "the robot type" (near ln. 23). There is insufficient antecedent basis for this limitation in the claim.

Claim 6 recites the limitation "the robot gripping system" (ln. 1). There is insufficient antecedent basis for this limitation in the claim.

Claim 8 recites the limitation "the weight removed hereby" (ln. 1). There is insufficient antecedent basis for this limitation in the claim and, further, this language is nonsensical.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 2, 4, 6 and 8-9 are rejected under 35 U.S.C. 102(b) as being anticipated by Van Durrett et al. ("Van Durrett")(US '571).

Van Durrett teaches a method and apparatus for separating comprising (Fig. 1a, 1b) comprising a weighing and scanning module (30), a robot (90), a control unit (70), and a stop station (near 50), wherein the incoming items are weighed and scanned at a supply position and then separated onto the respective pallets (col. 4, ln. 31 et seq.).

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Here, the weighing system is regarded as “integrated” with the gripper system as the two systems are jointly controlled and work in tandem to separate objects.

Claims 1, 2, 6 and 8-9 are rejected under 35 U.S.C. 102(b) as being anticipated by Huang et al. (“Huang”)(US ‘283).

Huang teaches a method and apparatus for separating comprising (Fig. 1, 2) comprising a weighing module (14), a robot (17, 19), a control unit (18) and a stop station (16), wherein the incoming items are weighed, scanned and separated onto the respective pallets (col. 9, ln. 36 et seq.). Here, the weighing system is regarded as “integrated” with the gripper system as the two systems are jointly controlled and work in tandem to separate objects.

Conclusion

Any references not explicitly discussed above but made of record are considered relevant to the prosecution of the instant application.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph C Rodriguez whose telephone number is **703-308-8342**. The examiner can normally be reached on M-F during normal business hours (9 am – 6 pm, EST).

The **Official** fax phone number for the organization where this application or proceeding is assigned is **703-872-9326** (After-Final **703-972-9327**).


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The **UnOfficial** fax phone number for the organization where this application or proceeding is assigned is **703-306-2571 or 703-308-6552**.

The examiner's **UNOFFICIAL Personal fax number** is **703-746-3678**.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the **Receptionist** whose telephone number is **703-308-1113**.

December 4, 2003


DONALD P. WALSH
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